THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HIROYUKI KAWAI, SHINJI SATO,
AKIRA NAGAHARA, SACHIO SASAKI,
MITSURU SATO, TAKEFUMI TAKAHASHI,
MASAHIRO WANOU, and MASAO KONISHI

Appeal No. 97-1044
Application 08/220,205[1]

ON BRIEF

Before URYNOWICZ,JERRY SMITH, and BARRETT,
Administrative Patent Judges.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-6, 9-12, 15-17, 20, 21, 24-28 and 31-42. Claims 7, 8, 13, 14, 18, 19, 22, 23, 29 and 30 have been indicated by the examiner as containing allowable subject matter. An amendment after final rejection was filed on August 22, 1995 and was entered by the examiner.

The disclosed invention pertains to an image forming apparatus for forming an image on a sheet of paper. Specifically, the invention is directed to the image forming apparatus being operable in either a horizontal position or in an upright position.

Representative claim 1 is reproduced as

a rotary endless latent image carrier;

image forming means for forming an electrostatic latent image on said latent image carrier;

developing means for developing said electrostatic latent image on said latent image carrier with a powdery developer;

toner supplementing means, provided with said developing means with inclination to a gravitational direction at both the upright position and the horizontal position of said apparatus, for supplementing toners to said developing means; and

transfer means for transferring said developed image on said image carrier to the sheet;
whereby the image forming apparatus is operable in both an upright position and a horizontal position.

The examiner relies on the following references:

Kita et al. (Kita)	5,270,785	Dec. 14, 1993 (filed July 07, 1992)
Tsusaka	5,383,009	Jan. 17, 1995 (filed May 11, 1993)

disclosure of Tsusaka. Claims 2, 9, 11, 24, 25, 27, 32, and 36-42 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Tsusaka taken alone. Claims 6, 12, 17, 21 and 28 stand rejected under 35 U.S.C. § 103 as being unpatentable over Tsusaka in view of Kita. Finally, claims 4, 10, 15, 20 and 26 stand rejected under 35 U.S.C. § 103 as being unpatentable over Tsusaka in view of Miyawaki.

Rather than repeat the arguments of appellants or the examiner, we make reference to the brief and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of anticipation and obviousness relied upon by the examiner as support for the rejections. We

forth in the brief along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the disclosure of Tsusaka fully meets the invention as recited in claims 1, 3, 5, 16, 31 and 33-35. We are also of the view that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 2, 4, 6, 9-12, 15, 17, 20, 21, 24-28, 32 and 36-42. Accordingly, we affirm.

Appellants' grouping of claims on page 15 of the brief is incomplete with respect to claims 33-35 and is inconsistent with respect to the rejections and claim dependencies as noted by the examiner [answer,

Thus, appellants have treated all claims subject to a given rejection as standing or falling together. Therefore, for each separate rejection advanced by the examiner, we will treat the claims subject to that rejection as standing or falling together. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983).

We consider first the rejection of claims 1, 3, 5, 16, 31 and 33-35 under 35 U.S.C. § 102(e) as anticipated by Tsusaka. We will consider independent claim 1 as the representative claim for this group. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which

Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Assoc, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

The examiner has read the various components of claim 1 on the Tsusaka disclosure, and the examiner observes that the image forming apparatus shown in Tsusaka's Figure 1 will operate in the horizontal position as shown and will also operate on one of its sides [answer, page 4]. Appellants do not dispute that the individual elements recited in claim 1 are present in the Tsusaka disclosure. Appellants' arguments are based on the position that there is no disclosure in Tsusaka that the image forming apparatus disclosed therein is intended to be operated in an upright position [brief, pages 16-17]. The examiner agrees

examiner asserts that the Tsusaka apparatus will produce at least one copy in the upright position and is, therefore, operable in that position.

We agree with the arguments presented by the examiner. Claim 1 merely recites that a device is operable in two different positions. The examiner has explained why the Tsusaka apparatus is operable in an upright position and a horizontal position. Appellants have provided no arguments which demonstrate error in the examiner's position. The lack of disclosure of an intent to use the Tsusaka apparatus in the upright position does not establish that the apparatus is not operable in the upright position.

Appellants assert that the apparatus of Tsusaka's Figure 1 would not be placed in an upright position on the left-hand side because the "top" of the

1. There is nothing about placing the Tsusaka apparatus in an upright position which would prevent the apparatus from continuing to operate to produce copies. Intent is not relevant here because the claimed structure exists in the applied prior art reference.

Appellants' arguments regarding the examiner's proposed modifications to the Tsusaka apparatus are misplaced. The examiner has not proposed any modifications to the Tsusaka apparatus. The examiner has demonstrated that all the elements of claim 1 are present in Tsusaka and that the Tsusaka apparatus is operable in an upright position. This showing is sufficient to support anticipation within the meaning of 35 U.S.C. § 102.

Appellants' arguments regarding the failure of

either the inventive concept of the claimed subject matter or the recognition of inherent properties that may be possessed by the prior art reference. Verdegaal Bros, Inc. v. Union Oil Co. of California, 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987).

Since appellants have not provided any evidence or arguments that the Tsusaka apparatus is not operable in an upright position, we sustain the rejection of claim 1 as anticipated by the disclosure of Tsusaka. Therefore, we also sustain the rejection of claims 3, 5, 16, 31 and 33-35 which are grouped therewith.

We now consider the rejection of claims 2, 9, 11, 24, 25, 27, 32 and 36-42 under 35 U.S.C. § 103 as unpatentable over the teachings of Tsusaka taken alone. These claims differ from the claims just considered by

supplementing means of Tsusaka is inclined approximately 45 degrees from the direction of gravity [answer, page 5]. Appellants make the same arguments discussed above and also argue that it would not have been obvious to modify Tsusaka to have the toner supplementing means inclined at an angle of 30 to 60 degrees with respect to the gravitational direction [brief, pages 20-23].

Just as we discussed earlier that no modification of Tsusaka is necessary to meet the language of claim 1, there is also no modification required to meet the language of claim 2. The Tsusaka toner supplementing means is inclined approximately 45 degrees from the direction of gravity as noted by the examiner. This meets the claim recitation that the angle is 30 to 60 degrees. Since the angular incline

obviousness, the claimed recitation of 30 to 60 degrees would have been obvious in view of the teachings of Tsusaka. Therefore, we sustain the rejection of claims 2, 9, 11, 24, 25, 27, 32 and 36-42 as being unpatentable over the teachings of Tsusaka.

We now consider the rejection of claims 6, 12, 17, 21, and 28 under 35 U.S.C. § 103 as unpatentable over the teachings of Tsusaka and Kita. These claims recite a vibration member for vibrating the toner supplemental means. The examiner cites Kita as teaching such a vibration member. Appellants rely only on their previous arguments that Tsusaka does not disclose an intent to operate in an upright position. Since we have previously determined that these arguments are not persuasive, we sustain the rejection of claims 6, 12, 17, 21, and 28 as unpatentable over

over the teachings of Tsusaka and Miyawaki. These claims recite a layer for reducing a frictional coefficient of the inner walls of the toner supplementing means. The examiner cites Miyawaki as teaching a Mylar coating for achieving this result. Appellants rely only on their previous arguments that Tsusaka does not disclose an intent to operate in an upright position. Since we have previously determined that these arguments are not persuasive, we sustain the rejection of claims 4, 10, 15, 20, and 26 as unpatentable over Tsusaka and Miyawaki.

In summary, we have sustained each of the examiner's rejections of the claims. Therefore, the decision of the examiner rejecting claims 1-6, 9-12, 15-17, 20, 21, 24-28 and 31-42 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

STANLEY URYNOWICZ Administrative Patent Judge	)	
JERRY SMITH Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
LEE BARRETT Administrative Patent Judge	)	

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Application No. 08/220,205

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